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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,523	02/21/2002	Hubert C. Kelley	11658.02	1027
38598	7590	09/10/2004	EXAMINER	
ANDREWS KURTH L.L.P. 1701 PENNSYLVANIA AVENUE, N.W. SUITE 300 WASHINGTON, DC 20006			ALABAIDI, HAYTHIM J	
			ART UNIT	PAPER NUMBER
			2171	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/081,523	KELLEY, HUBERT C.	
	Examiner	Art Unit	
	Haythim J. Alaubaidi	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ^o | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/21/02</u> ^o | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is a first non-final office action in response to Application 10/081523 filed on February 23, 2001.
2. Claims 1-44 are presented for examination, of which Claims 1, 2, 20, 41 and 43 are independent claims.
3. Claims 2, 41 and 43 are rejected under 35 U.S.C. 101.
4. Claim 1, is rejected under 35 U.S.C. 102(b).
5. Claims 2-44 are rejected under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 2, 41 and 43, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to

Art Unit: 2171

promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (Ex parte *Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present Application, claims 2, 41 and 43, all recites an abstract idea at the preamble; in addition, the steps in the claim body merely receiving documents maintaining a repository and organizing the documents, which can be implemented by the mind of a person or by the use of a pencil and paper. In another words, since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deems to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, is rejected under 35 U.S.C. 102(b) as being anticipated by William Athing (U.S. Patent No. 5,987,498 and Athing hereinafter).

Regarding Claim 1, Athing discloses,

- electronically receiving a plurality of documents, (Figure No. 6, Element No. 212 and corresponding text) each of the documents being received from an authoring entity of the corresponding document (Figure No. 7, Elements 242-250 and corresponding text; see also Figure No. 18, i.e. From);

- maintaining a central repository for electronically storing the documents, including (Figure No. 3, Element No. 64 and corresponding text)

associating each of the documents with the corresponding authoring entity (Figure No. 7, Elements 242-250 and corresponding text; see also Figure No. 18, i.e. From); and

identifying a subject matter for each of the documents (Figure No. 18, i.e. Subject/text and corresponding text);

Art Unit: 2171

- selectively providing access to the stored documents in the central repository (Figures 14 and 15 and corresponding text); and
- selectively permitting downloading of the stored documents from the central repository (Figure No. 18 and corresponding text).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Regarding Claims 2-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over William Athing (U.S. Patent No. 5,987,498 and Athing hereinafter) in view of John Maxwell (U.S. Patent No. 6,098,070 and Maxwell hereinafter).

Regarding Claims 2, 20, 41 and 43, Athing discloses,

- receiving document, from corresponding representatives without requiring submission of the documents (Figure No. 18 and corresponding text; see also Col 5, Lines 4-6, 13-16 and 23-24)¹;

¹ The user checking his/her e-mails (documents) from a corresponding representative (the sender or the originator of the email) in figure No. 18 is receiving (viewing) the emails (document) without the submission requirement of another entity, because it was maintained by the server until the user gets to Figure No. 18 and is able to view them.

Art Unit: 2171

- maintaining a central repository for electronically storing the documents, (Figure No. 1, Element No. 38) including:
- organizing the documents in a data structure (Figure No 18 and corresponding text); and

Athing reference discloses all of the claimed subject matter set forth above including and/or more specific to web-based e-mails, retrieving and composing them, except it does not explicitly indicate the step of litigation-related documents; associating each of the litigation-related documents with the corresponding adjudication entity in which the litigation-related document was filed; and selectively providing access to the stored litigation-related documents. However Maxwell teaches litigation-related documents (Figure No. 2, Element 230; see also Figure No. 5B, Settlement Type: Litigation); associating each of the litigation-related documents with the corresponding adjudication entity in which the litigation-related document was filed (Figure No 16 and corresponding text); and selectively providing access to the stored litigation-related documents (Col 20, Line 60 through Col 21, Line 12; see also Col 19, Lines 37-38).

Given the intended broad application of the Athing system, It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Athing with the teachings of Maxwell to include a litigation-related documents with its filing in a judicial system (such as in Maxwell) and implement it in a web based environment; in order to reach a larger number of subscribers which would lead to an increase revenue (see Claims 13-14 and 16-17).

Regarding Claims 3, 11, 23 and 32, Athing discloses permitting the downloading of the documents in a plurality of formats (Athing, Figure No. 16 and corresponding text; see also Maxwell, Figure No 29, Element No. 2915).

Regarding Claims 4, and 24-25, the limitations of this claim was discloses in the rejection of Claims 2 and 3, above. It is therefor rejected as set forth.

Regarding Claims 5 and 26, Maxwell discloses receiving a search query, searching the database and providing the results (Col 6, Lines 49-55; see also Col 18, Line 53 through Col 19, Line 4).

Regarding Claims 6-7 and 27-28, the limitations of this claim was discloses in the rejection of Claim 2, above. It is therefor rejected as set forth.

Regarding Claims 8 and 29, Maxwell discloses exhibits (Maxwell, Figure No. 2, Element No. 245).

Regarding Claims 9 and 30, the limitations of this claim was discloses in the rejection of Claim 2, above. It is therefor rejected as set forth.

Regarding Claims 10 and 31, Maxwell discloses third parties (Col 2, Lines 18-26).

Regarding Claims 12, 33, 42 and 44, Maxwell discloses hard copies (Figure No. 1, Element 125 and corresponding text).

Regarding Claims 13-14, 16-17, 34-35 and 37-38, Athing discloses charging a fee for the on-line access (Figure No. 11 and corresponding text).

Art Unit: 2171

Regarding Claims 15 and 36, Athing discloses advertisements (Col 8, Lines 8-20).

Regarding Claims 18 and 39, Athing discloses hyper linking a document (Col 2, Lines 39-43)².

Regarding Claims 19 and 40, the limitations of this claim was discloses in the rejection of Claims 8 and 18, above. It is therefor rejected as set forth.

Regarding Claims 21 and 22, Athing discloses a network location address Figure 3, Element No. 62 and corresponding text).

Other Prior Art Made of Record

12. a. Montville et al. (U.S. Patent No. 6356937) discloses a full-featured web-based and client-side e-mail system.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Points of Contact

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950 and starting October 18 2004 the telephone number will change to (571) 272-4014. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.


Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6th Floor Receptionist, Arlington, Virginia. 22202.

Haythim J. Alaubaidi

Patent Examiner
Technology Center 2100
September 7, 2004


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

² An e-mail document in a web-based environment is the hyperlink.